

## **REMARKS**

Applicants reply to the Final Office Action dated November 10, 2010 within two months. Claims 1-8, 10-16, 18, 20-22 and 27-29 were pending in the application and the Examiner rejects claims 1-8, 10-16, 18, 20-22 and 27-29. Applicants cancel claim 8 without prejudice to filing one or more claims having similar subject matter in other applications. Support for the amendments and new claims may be found in the originally-filed specification. No new matter is entered with these amendments or new claims. Applicants respectfully request reconsideration of this application.

### **Rejections under 35 U.S.C § 112**

The Examiner rejects claim 1-8, 10-16, and 18, 20-22 and 27-29 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner states “the application does not support ‘does not include a pre-stored user ID or logon identifier’ as in the claims. It is pointed out that ‘without requiring’ is different than ‘does not include a pre-stored user ID or logon identifier.’ Further just in general it seems odd that there would not be a user ID of some type stored in the system for an existing customer.” Also, the Examiner states on pages 7 and 8 of the Office Action that “Applicant’s claims have ‘first application and second application are applications for identical products or services’ where there is no written disclosure of this requirement in the instant application... Additional accounts and services are not identical. If they were, the specification would teach the same or identical accounts or services.” These contentions are respectfully traversed.

When a disclosure describes a claimed invention in a manner that permits one skilled in the art to reasonably conclude that the inventor possessed the claimed invention the written description requirement is satisfied. (MPEP §2163 (emphasis added)). This possession may be shown in any number of ways and Applicants need not describe every claim feature exactly because there is no in haec verba requirement. (MPEP § 2163). Rather, to satisfy the written description requirement, all that is required is “reasonable clarity.” (MPEP § 2163.02). Also, an adequate description may be made in any way through express, implicit, or even inherent disclosures in the application, including words, structures, figures, diagrams, and/or formulae. (MPEP §§ 2163(I), 2163.02). Finally, it is important to be mindful of the generally inverse correlation between the level of skill and knowledge in the art and the specificity of disclosure necessary to satisfy the written description requirement. (MPEP § 2163(II)(A)(2)) (inventions in “predictable” or “mature” require a lesser showing of possession than inventions in more “unpredictable” arts).

Applicants submit that one of ordinary skill in the art would reasonably conclude that Applicant's disclosure adequately described the claimed invention at the time of filing at least because: Paragraph [0007] of the application as filed states "Upon receiving a selection of the indicator from the customer, the financial institution may transmit a second new account application to the customer in place of the initial account application. The second new account application has a fewer number of fields for entering the personal identification and financial information than the first new account application, and in various embodiments, may require only the entry the customer's name, a portion of a government identification number (such as a social security number) of the customer, an account number of an existing account of the customer, and a confirmation number associated with the existing account. In various embodiments, the customer does not need to provide a login/user name identifier or a password to receive the shorter new account application." Those of ordinary skill in the art would understand that such a disclosure at least implies "wherein the reviewed personal identification, financial information, and selection of a check box does not include a pre-stored user ID or logon identifier," as recited by independent claim 1 and as similarly recited by independent claims 21 and 22. Thus, the present application adequately describes the claimed invention. Applicants respectfully request favorable reconsideration and withdrawal of the rejection under 35 U.S.C. § 112.

Moreover, with all due respect, the claims do not state that "a user ID of some type is not stored in the system for an existing customer" as offered on pages 5 and 6 of the Office Action by the Examiner. The claims state that a user ID is not part of an Applicant's first account application.

As to the limitation "wherein the first application and the second application are applications for identical products or services" failing to comply with the written description requirement, one of ordinary skill in the art would reasonably conclude that Applicant's disclosure adequately described the claimed invention at the time of filing, by reviewing at least paragraph [0001], and paragraphs [0005]-[0009]. For instance, paragraph [0007] of the application as filed states "Upon receiving a selection of the indicator from the customer, the financial institution may transmit a second new account application to the customer in place of the initial account application." Stated another way, the second application and the first application are both for acquiring additional financial products or services, (i.e. the same additional financial products or services). The shorter second application makes this process attempted but not completed via the first application easier. As such, Applicants respectfully request favorable reconsideration and withdrawal of the rejection under 35 U.S.C. § 112.

The Examiner rejects claim 1-8, 10-16, and 18, 20-22 and 27-29 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner states on pages 6 that “there is no written disclosure of ‘reviewing...a plurality of fields...’ for automatic determination. If an identification of an existing account (e.g. account number) is put into a form, another form is automatically presented.” Applicants respectfully disagree with these rejections, but Applicants present claim amendments in order to clarify the patentable aspects of the claims and to expedite prosecution. Support for the amendments may be found in at least paragraph [0009] as filed. Applicants respectfully request favorable reconsideration and withdrawal of the rejection under 35 U.S.C. § 112.

In the event that the Office maintains these rejections under 35 U.S.C. § 112, Applicants respectfully request, in the interest of its policy of compact prosecution, that the Examiner explain how the aforementioned portions of the present application fail to communicate to a skilled artisan that Applicants possessed the claimed invention.

Rejections under 35 U.S.C § 103

The Examiner rejects claims 1-7, 10-16, 20-22 and 27-29 under 35 U.S.C. § 103(a), as being unpatentable over Sidles, U.S. Patent Application No. 2002/0062342 (“Sidles”) in view of Oyama et al., U.S. Patent Application Publication No. 2002/0007343 (“Oyama”). The Examiner rejects claims 8 and 18 under 35 U.S.C. § 103(a), as being unpatentable over Sidles in view of Oyama in further view of Klug et al., U.S. Patent Application No. 5,790,785 (“Klug”). Applicants respectfully disagree with these rejections, but Applicants present claim amendments in order to clarify the patentable aspects of the claims and to expedite prosecution.

First, as a matter of procedure, the Examiner states on page 14 of the Office Action, “It would have been obvious to one of ordinary skill in the art at the time of invention to include in the application forms of Sidles an account application form motivated by Oyama et al. as an account application form is simply another type of application or registration form and this would be useful for credit cards as taught by Sidles.” The Examiner, however, does not explain why including the application forms of Sidles “would be useful” or point to any factual support for that determination. The initial burden is on the Examiner to provide a factual basis to support an obviousness conclusion. *In re Warner*, 379 F.2d at 1017. No such basis has been provided. Moreover, even if including the application forms would be useful, the Examiner has not articulated why that knowledge would have been known to one with ordinary skill in the art. Thus, Examiner has not

established their *prima facie* case of obvious. Applications respectfully request the finality of this Action be removed so that the Examiner may adequately respond to this concern.

Second, Sidles generally teaches “methods for automatically complying with requests for information received from a wide area network, such as the Internet,” (abstract). Specifically, Sidles teaches in paragraph [0058] “There are two categories of data that can be filled in: Profile data (first name, last name, address, credit card information) are inserted into vendor checkout forms of the type just described. Non-profile data (typically a simple user name and password pair, or PIN, PKI certificate, etc.) are required to be submitted by many systems, such as Microsoft’s Hot Mail electronic mail system, to identify a user each time he or she enters a web site. The first time a user receives a form requesting non-profile data, the user enters his or her chosen user name and password (PIN, etc.) manually. After that, such forms are automatically pre-filled by the present system without user intervention,” (emphasis added). Stated another way, Sidles requires non-profile data, namely a user name and password pair to function as intended. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, (such as eliminating the required step in the present case) then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (MPEP 2343.01 V.) Also, claim terms must not be interpreted in a vacuum, devoid of the context of the claim as a whole. See *Hockerson-Halberstadt, Inc. v. Converse Inc.*, 183 F.3d 1369, 1374 (Fed. Cir. 1999) (“proper claim construction ... demands interpretation of the entire claim in context, not a single element in isolation.”); *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003) (“While certain terms may be at the center of the claim construction debate, the context of the surrounding words of the claim also must be considered....”). Thus, Sidles is an inappropriate reference for inclusion and combination and teaches away from “wherein the received first account application does not include a pre-stored user ID or logon identifier” as recited by independent claim 1 (emphasis added) and as similarly recited by independent claims 20 and 27.

Also, specifically Sidles teaches “user accesses and updates or corrects the contents of the wallet database 1100,” ([0069]). However, a user logging into the wallet database is not analogous to nor does it disclose or contemplate “verifying the information provided in the first account application against stored information of the existing transaction account to update customer information,” as recited by independent claim 1 (emphasis added) and as similarly recited by independent claims 20 and 27. Sidles is also silent as to “receiving an incomplete first account

application of a customer, including the name of a customer and less than all of a government identification number," as recited by independent claim 1 (emphasis added) and as similarly recited by independent claims 20 and 27.

Oyama generally teaches "a network transaction system applicable to cyberspace banking services using an open network, which allows customers to authenticate themselves through a simplified procedure," (abstract). Oyama is silent to and thus does not disclose or contemplate "verifying the information provided in the first account application against stored information of the existing transaction account to update customer information," and "receiving an incomplete first account application of a customer, including the name of a customer and less than all of a government identification number," as recited by independent claim 1 (emphasis added) and as similarly recited by independent claims 20 and 27.

Klug generally teaches "a World Wide Web registration processing system for assisting World Wide Web users in registering as World Wide Web web sites" (abstract). Moreover, Klug similar to Oyama above, is silent to and thus does not disclose or contemplate "verifying the information provided in the first account application against stored information of the existing transaction account to update customer information," and "receiving an incomplete first account application of a customer, including the name of a customer and less than all of a government identification number," as recited by independent claim 1 (emphasis added) and as similarly recited by independent claims 20 and 27.

Thus, the cited references alone or in combination do not disclose or contemplate at least "verifying the information provided in the first account application against stored information of the existing transaction account to update customer information," and "receiving an incomplete first account application of a customer, including the name of a customer and less than all of a government identification number," as recited by independent claim 1 (emphasis added) and as similarly recited by independent claims 20 and 27.

Dependent claims 2-7, 10-16, 18, and 21-22 variously depend from independent claims 1 and 20. Therefore, Applicants assert that dependent claims 2-7, 10-16, 18, and 21-22 are patentable for at least the same reasons stated above for differentiating independent claims 2-8, 10-16, 18, and 21-22, as well as in view of their own respective features.

When a phrase similar to "at least one of A, B, or C" or "at least one of A, B, or C" is used in the claims or specification, Applicants intend the phrase to mean any of the following: (1) at least one of A; (2) at least one of B; (3) at least one of C; (4) at least one of A and at least one of B; (5) at

least one of B and at least one of C; (6) at least one of A and at least one of C; or (7) at least one of A, at least one of B, and at least one of C.

Applicants respectfully submit that the pending claims are in condition for allowance. The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. **19-2814**. Applicants invite the Examiner to telephone the undersigned, if the Examiner has any questions regarding this Reply or the present application in general.

Respectfully submitted,

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